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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,617	11/09/2001	Mark Scott McCoy	MCOY-001COA	9302

7590

02/26/2003

Andrew D. Gathy
Sierra Patent Group, Ltd.
P.O. Box 6149
Stateline, NV 89449

EXAMINER

WALLS, DIONNE A

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,617

Applicant(s)

MCCOY, MARK SCOTT

Examiner

Dionne A. Walls

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-10, 12 and 14-16 is/are rejected.
- 7) ☒ Claim(s) 11 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on December 16th, 2002 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US. Pat. No. 6,354,301 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Election/Restrictions

2. Applicant's election of Invention II, claims 8-15, was indicated in the Previous Office Action mailed on September 19th, 2002, and has been acknowledged by Applicant in the Amendment filed on December 16th, 2002. Because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Objections

3. Applicant is advised that should claim 12 be found allowable, claim 16 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof (i.e. Independent claim 8, and dependent claim 12). When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 8-10, 12, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kretzner (US. Pat. No. 1,957,143) in view of Groulx (US. Pat. No. 2,129,129) and Carabias (US. Pat. No. 933,360).

Kretzner discloses all that is recited in the claims (Note: "a" corresponds to the claimed "lower chamber member"; "c" corresponds to the claimed "bowl portion"; "z" corresponds to the claimed "vapor intake orifice"; "e"/ "f"/ tubular part of "a" correspond to the claimed "vapor intake conduit"; "d" corresponds to the claimed "smoking pipe conduit"; "b" corresponds to the claimed "upper chamber member") except it may not specifically disclose a lower screen member disposed in the bowl portion of the lower chamber and a generally-conical-shaped heat intake conduit. However, Groulx discloses a screen for tobacco pipes which is adapted to be inserted into the bowl of a tobacco pipe for holding tobacco clear from the bottom of the pipe bowl (see figs). Therefore, would have been obvious to one having ordinary skill in the art at the time of the invention to modify the bowl of Kretzner to include the metal screen of Groulx in order to prevent tobacco particles from being drawn into the mouth, and also from plugging or clogging the passage through the stem and through which the smoke is drawn, as taught in Groulx (see page 1, col. 1, lines 12-16). Also, while the device of Kretzner modified by Groulx may not disclose an upper chamber member including a generally-conical-shaped heat intake conduit, Carabias discloses an inhaler in the form of a smoking pipe which has a bowl B, the outlet of which is shaped in a generally

conical manner (see fig. 3). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the outlet portion of the upper chamber member of Kretzner (which would obviously be adapted to accept an output from a heat source such as a match or heat gun) such that it resembled the cone shape outlet of the pipe in Carabias since a pipe having a bowl outlet of said shape is known in the tobacco art as evidenced by the disclosure of Carabias. Lastly, while there may be no articulation, in the combined references, that the lower and upper chambers are mated in a substantially airtight manner, it follows that this is the case since the chambers are joined in such a manner where in they are mated by external/internal threads on the surfaces of the respective members, such threading being conventional means in which to secure/connect two pieces in an airtight manner.

Regarding claim 15, while the device of the combined references may not have the exact threaded structure of that claimed, this limitation is not deemed to patentably distinguish the claim from the reference as the surfaces utilized to mate the two members together are obvious modifications since it is well known to utilize these means in securing items together – whether the threading is located on the exterior or interior of the respective pieces.

Regarding claims 12 and 16, the screen of Groulx includes coiled wire 11, which would inherently serve to create turbulence in the smoke/air that passes between/through the coils and into the mouth of the smoker. Alternatively, the coils 11 of the screen of Groulx would obviously cause turbulence in the smoke that passes over them since they occupy space in the pathway of the smoke which would result in a

impediment to the smoke thus creating some disruption of an otherwise smooth flow of smoke into the mouth of the smoker.

Allowable Subject Matter

3. Claims 11 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
4. The indicated allowability of claim 12 is withdrawn in view of the newly discovered reference to Groulx. Rejections based on the newly cited reference have been stated above.

Response to Arguments

5. Applicant's arguments filed December 16th, 2002 have been fully considered but they are not persuasive.

- Applicant argues that the Kretzner reference has no teaching or suggestion to modify the top insert piece b ("upper chamber member"), the Carabias reference has no teaching or suggestion to modify a smoking pipe to accept an output nozzle of a heat gun and, therefore, it would not have been obvious to combine the Kretzner reference with the Carabias reference. However, the Examiner disagrees. In response to applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Carabias reference, which shows a pipe having a generally-conically shaped bowl outlet, would suggest to one having ordinary skill in the art to fabricate a pipe having similar shape, since this shape is one that is known in the art, and could be the basis of a suitable design choice for any pipe bowl outlet. Contrary to Applicants assertions, the Examiner believes that the inherent conical nature of such a bowl outlet would allow it to be capable of accepting an output nozzle of a heat gun, as is claimed. Where the claimed and prior art product/apparatus is identical or substantially identical in structure or composition, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430,433 (CCPA 1977). In other words, when the structure recited in the reference is substantially identical to that of the claims, the claimed properties or functions (i.e. adaptability to accept an output nozzle of a heat gun) are presumed to be inherent.

- Applicant asserts that it is improper to rely on what is well-known in the art when, in the Office Action, the Examiner states that it is well-known to render the claimed elements of the upper chamber being adapted to mate with the lower chamber by threads disposed on mating surface. However, the Examiner disagrees. As stated above, one of the ways to establish obviousness is to indicate knowledge generally available to one of ordinary skill in the art. The Examiner believes that one having ordinary skill in the art would be well-aware of the threaded structure of mated surfaces such that the claimed recitation reciting this type of mated relationship would be *not*

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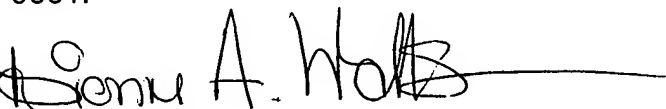
unobvious over this general knowledge. The Kretzner reference already shows a threaded mating of the upper and lower chambers; however, there may be no explicit showing of the exact threading relationship as claimed. However, this is not deemed to patentably distinguish the claims over the references since the manner in which the surfaces are threaded – whether the threads be interiorly or exteriorly disposed – is an obvious modification.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to read "Dionne A. Walls", with a long horizontal line extending to the right.

Dionne A. Walls
February 24, 2003